

REMARKS

Claims 40-59 were pending in this application.

Claims 40-59 have been rejected.

Claim 40 has been amended as shown above.

Claims 40-59 remain pending in this application.

Reconsideration and full allowance of Claims 40-59 are respectfully requested.

I. FINALITY OF OFFICE ACTION

The Office Action dated June 29, 2007 was improperly made final.

A final Office Action rejecting Claims 40-59 was mailed on December 15, 2006. A response to the final Office Action was filed on February 15, 2007. This response attempted to amend Claim 54 (and only Claim 54) as follows:

54. (Currently Amended) A method, comprising:
providing a laser operable to irradiate a sclera of an eye in a
region of a ciliary body of the eye; and
operating the laser to irradiate the sclera in the region of the
ciliary body to increase an effective working distance of a ciliary
muscle of the eye.

In an Advisory Action dated March 13, 2007, the Examiner refused to enter the amendment, saying that this amendment raised new issues that would require further search and/or consideration.

In a Request for Continued Examination (RCE) filed on April 9, 2007, the Applicant amended Claim 54 as follows:

54. (Currently Amended) A method, comprising:

providing a laser operable to irradiate a sclera of an eye in a region of a ciliary body of the eye; and
operating the laser to irradiate the sclera in the region of the ciliary body to increase an effective working distance of a ciliary muscle of the eye;
wherein operating the laser to irradiate the sclera in the region of the ciliary body comprises reducing a thickness of the sclera in the region of the ciliary body without forming an opening completely through the sclera.

The amendments to Claim 54 in the RCE included the exact same amendments that the Examiner previously determined would require further search and/or consideration.

It is not proper to make final a first Office Action after an RCE where the RCE contains material “which was presented ... after final rejection ... but was denied entry because ... new issues were raised that required further consideration and/or search.” (MPEP § 706.07(b), which is applied to RCEs via MPEP § 706.07(h)(VIII)). As a result, the Office Action dated June 29, 2007 cannot be made final.

II. OBJECTION TO OATH/DECLARATION

The Office Action objects to the originally filed declaration because this application presents a claim for subject matter not originally claimed or embraced in the statement of the invention (namely, the use of a laser). In response, the assignee of this application is filing a Petition Under 37 C.F.R. § 1.47(b) due to the inventor’s unavailability or unwillingness to sign the Declaration and Power of Attorney, which was delivered to the inventor’s last known address in March 2007.

III. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 40-59 under 35 U.S.C. § 102(b) as being anticipated by March et al., “Safety of High-Energy Neodymium:YAG Laser Pulses in YAG Sclerostomy” (“*March*”). This rejection is respectfully traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

To establish inherency, the burden is on the Patent Office to present evidence clearly showing that “the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (*MPEP* § 2112). However, the fact that a “certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (*MPEP* § 2112). The Patent Office must “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows” from the teachings of cited reference. (*MPEP* § 2112).

Claims 40, 47, and 54 recite irradiating a sclera of an eye to “increase an effective working distance of a ciliary muscle of the eye.” The Examiner never shows that this inherently occurs in *March*. Rather, *March* simply recites a technique for using laser pulses to form a “new channel for

drainage of aqueous humor” in order to treat glaucoma. (*March*, Page 584, Left column, Introduction). The Examiner assumes that the laser pulses in *March* “weaken the sclera of the eye” as recited in Claim 40. The Examiner assumes that the laser pulses in *March* cause expansion of the scleral in the eye being treated. The Examiner assumes that the laser pulses in *March* allow an effective working distance of the ciliary muscle of the eye being treated to increase.

The Examiner cites nothing in *March* actually supporting these assumptions. Rather, the Examiner cites the “laws of physics” (12/15/06 Office Action, Page 3, Second paragraph) and assumes that irradiating the sclera of the eye in any way weakens the eye and increases the effective working distance of the ciliary muscle. The burden to prove inherency cannot be met by showing that something might occur in a cited reference. The burden to prove inherency requires a showing that something must be present in the cited reference (the missing descriptive matter is necessarily present in the reference).

The Examiner’s references to the “laws of physics” aside, the Examiner has never explained why *March* must inherently lead to an increase in the effective working distance of the ciliary muscle of the eye. The Applicant has previously noted that *March* is designed to lower intraocular pressure in the eye in order to treat glaucoma. The treatment of *March* is therefore specifically designed to lower the internal pressure of the eye, not to increase the internal pressure of the eye. The Examiner has never explained how the lower internal pressure of the eye after treatment in *March* must inherently lead to an increase in the effective working distance of the ciliary muscle of the eye.

The Examiner also asserts that the “pressure of the eye changes constantly” and states that the

claims “make no reference to the changing pressure in [the] eye.” (03/13/07 *Advisory Action*, Page 2). However, the claims do not need to “reference to the changing pressure in the eye” in order to be patentable. Claims 40, 47, and 54 recite irradiating a sclera of an eye to “increase an effective working distance of a ciliary muscle of the eye.” The claims are therefore clear – the sclera of an eye is irradiated to increase the effective working distance of the ciliary muscle of the eye. *March* contains absolutely nothing that anticipates an increase in the effective working distance of the ciliary muscle of the eye. The claims cannot be anticipated by *March* simply because the claims lack a reference to changing pressures in the eye.

Claims 40, 47, and 54 also recite “reducing a thickness of the sclera in the region of the ciliary body without forming an opening completely through the sclera.”

The Examiner asserts that *March* discloses prior glaucoma treatments that do not completely perforate the sclera. (06/29/07 *Office Action*, Page 2, *Second paragraph*). *March* simply states that “none of these previous [laser] treatments created a complete scleral perforation or sclerostomy as is done with a scalpel in the standard surgical treatment for glaucoma.” (*March*, Page 586, *Right column, First paragraph*).

This portion of *March* says absolutely nothing about increasing the effective working distance of the ciliary muscle of the eye. Once again, the Examiner assumes that these previous laser treatments “weaken the sclera of the eye” as recited in Claim 40. Once again, the Examiner assumes that these previous laser treatments cause expansion of the scleral in an eye being treated in *March*. Once again, the Examiner assumes that these previous laser treatments allow an effective working

distance of the ciliary muscle of the eye to be increased. And once again, the Examiner fails to show that the previous laser treatments described in *March* must inherently lead to an increase in the effective working distance of the ciliary muscle of the eye. In fact, the Examiner cannot even show that these previous laser treatments occurred anywhere near the ciliary body of the eye.

The Examiner also asserts that the “first 10 shots (i.e. prior to the endpoint of treatment)” reads on the claimed invention. (06/29/07 Office Action, Page 2, Second paragraph). *March* simply recites how a pulsed laser can be used to form channels in the sclera of an eye. (*March*, Page 584, Right column).

This portion of *March* says absolutely nothing about how laser pulses forming a channel partially through the sclera increase the effective working distance of the ciliary muscle of the eye. Once again, the Examiner assumes that the laser pulses forming a channel partially through the sclera “weaken the sclera of the eye” as recited in Claim 40. Once again, the Examiner assumes that the laser pulses forming a channel partially through the sclera cause expansion of the sclera in the eye being treated in *March*. Once again, the Examiner assumes that the laser pulses forming a channel partially through the sclera allow an effective working distance of the ciliary muscle of the eye to be increased. And once again, the Examiner fails to show that the laser pulses forming a channel partially through the sclera must inherently lead to an increase in the effective working distance of the ciliary muscle of the eye.

The Examiner has only shown that *March* irradiates the sclera of an eye. The Examiner has never shown that this irradiation weakens the sclera. The Examiner has never shown that this

irradiation allows expansion of the sclera. The Examiner has never shown that this irradiation increases the effective working distance of the ciliary muscle. The Examiner has simply assumed that this is true in *March*. The Examiner has never satisfied the burden specified in MPEP § 2112, which requires the Examiner to present “evidence clearly showing that ‘the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” The Examiner has not even shown that the irradiation in *March* occurs over a large enough area to allow an increase in the effective working distance of the ciliary muscle of the eye.

For these reasons, *March* fails to anticipate the Applicant’s invention as recited in Claims 40, 47, and 54 (and their dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 40-59

SUMMARY

The Applicant respectfully submits that all pending claims are in condition for allowance and respectfully requests full allowance of all pending claims.


If any issue arises or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any additional extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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